

REMARKS

This amendment is submitted with a request for a one month extension and appropriate fee in reply to the Office Action dated July 5, 2006, and subsequent to the telephone interview conducted on September 25, 2006. Claims 23-34 currently stand rejected. Applicant has amended claims 23-27, 31 and 33 to more particularly distinguish the claimed invention from the cited references. Former independent claim 34 has been amended to depend from independent claim 23. Newly added claims 35-45 have been added to further define patentable aspects of the invention. No new matter has been added by the amendment. Claim 29 has been canceled, without prejudice.

In light of the amendment and the remarks presented below, Applicant respectfully requests reconsideration and allowance of all now-pending claims of the present application.

Claim Rejections - 35 USC §103

Claims 23-34 currently stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sakurai (U.S. Patent No. 6,600,930) in view of Freeland et al. (U.S. Patent Application Publication No. 2003/0028380, hereinafter "Freeland"). Claim 29 has been canceled, without prejudice, and thus the rejection of claim 29 is now moot.

Independent claim 33 has been amended to recite, *inter alia*, receiving a search term for a search engine offline. In other words, the controller of the claimed invention receives the search term before establishing a connection with a server. Thus, according to embodiments of the claimed invention, user expense is spared by avoiding conduct of search term entry on-line as described at page 2, lines 27-31 of the specification as filed. Applicant respectfully submits that similar recitations with respect to the feature described above in independent claim 33 are also included in independent claims 23 and 31, which are directed to corresponding device and system claims, respectively.

Sakurai is directed to an information provision system capable of communicating information between a server and a plurality of portable radiocommunication terminals. Sakurai discloses in one embodiment according to FIGS. 6 and 7, that a web browsing function may be executed to connect a member terminal (1) to a common server (2) for receipt of information at

the member terminal (1) according to prior art methods. Specifically, the member terminal (1) requests a connection to the common server (2) at step S2. Thereafter, following connection at step S4, the common server (2) sends information to the member terminal (1) at step S6 and following. Thus, contrary to the claimed invention, Sakurai discloses establishing a connection to the common server prior to receiving a search term (i.e., on-line entry of the search term). In fact, the method disclosed in Sakurai represents a known method of utilizing a web browser, which the claimed invention is directed to remedying by permitting search terms to be entered prior to connection to the server in order to reduce connection time wasted during search term entry as described above. Thus, FIGS. 6 and 7 of Sakurai fail to teach or suggest receiving a search term for a search engine offline as recited in the claimed invention.

It should be noted that Sakurai also discloses, in a separate embodiment according to FIGS. 9 and 10, a facsimile transmission function in which input text is inserted at step S1 and a destination telephone number is input at step S3, the terminal connects to a server at step S5, transmission and processing then occurs and the member may be informed of reception at S17. However, the fax transmission function of FIGS. 9 and 10 is unrelated to conduct of a search. In this regard, neither insertion of the input text nor insertion of the destination telephone number can fairly be asserted to correspond to entry of a search term for a search engine. Thus, FIGS. 9 and 10 of Sakurai also fail to teach or suggest receiving a search term for a search engine offline as recited in independent claim 33. In fact, Applicant respectfully submits that all of Sakurai fails to teach or suggest the above recited feature.

Applicant respectfully notes that it appears that the Office Action combined the embodiment of FIGS. 6 and 7 with the embodiment of FIGS. 9 and 10 in rejecting the claimed invention. Notwithstanding the fact that the above recited feature is neither taught nor suggested in any part of Sakurai, Applicant still submits that even if it were assumed that the separate embodiments of FIGS. 6 and 7 and FIGS. 9 and 10 disclosed all the elements of the claimed invention, such combination would not be proper. In this regard, although Sakurai discloses at col. 19, lines 51-55 that the user may select a desired function of the mobile terminal which may execute a browser function, it is clear that if the browser function of Sakurai were to employ a search, such a search would be performed in accordance with FIGS. 6 and 7, while if a fax

transmission function were to be performed, such a function would be performed in accordance with FIGS. 9 and 10. As such, any combination of these separate embodiments would be improper without an express showing of some motivation to do so.

As such, Applicant initially submits that the processes of FIGS. 6 and 7 are not related to the processes of FIGS. 9 and 10. Accordingly, even if one were to assume for the sake of argument that the combination of these separate embodiments disclosed all the features of the claimed invention (an assumption with which Applicant expressly disagrees) there would still be no motivation for one skilled in the art to combine steps from the different embodiments of Sakurai to achieve the claimed invention. In this regard, there would be no reason to modify Sakurai's clear teaching of conventional methods of performing an online search (i.e., establishing a connection prior to inputting search terms for conducting a search) based on Sakurai's disclosure of fax transmission functionality described at col. 24, lines 35-44 and col. 19, line 44 to col. 20, line 6. To the contrary, the cited passages are merely related to the performance of a fax transmission function that is unrelated to a search according to the claimed invention. Furthermore, a combination of the embodiments of the embodiment of FIGS. 6 and 7 with the embodiment of FIGS. 9 and 10 would merely result in a device capable of performing both a fax transmission function and a search function in which input text is received for fax transmission prior to connection to a server, and after connection to the server is accomplished, search terms may be input into a search engine in a conventional fashion. Thus, there is neither motivation to make a combination of these separate embodiments nor would such combination meet the claimed invention. As such, Sakurai fails to teach or suggest receiving a search term for a search engine offline as recited in the claimed invention.

The Office Action also cites Freeland in connection with the rejection of independent claims 23, 31 and 33. In this regard, the Office Action cites Freeland as disclosing a phone that receives information identifying a user's favorite search engine to carry out a search using a search term. However, even assuming Freeland discloses what it is alleged to disclose, Freeland still fails to cure the noted deficiencies of Sakurai as described above. Specifically, Freeland also fails to teach or suggest receiving a search term for a search engine offline as recited in the claimed invention. To the contrary, Freeland is directed to a conventional process in which a

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user navigates to a search engine and supplies a search term after (not before) a connection is established (see paragraph [0272]). As such, Freeland, like Sakurai discloses an on-line entry of search terms during a connection. Accordingly, Freeland also fails to teach or suggest receiving a search term for a search engine offline as recited in the claimed invention.

Since both Freeland and Sakurai fail to teach or suggest the above recited feature, any combination of the cited references also fails to teach or suggest the above recited feature of the claimed invention. Thus, the independent claims of claimed invention (i.e., independent claims 23, 31, and 33) are each patentable over the cited references. Claims 24-28, 30, 32 and 34 depend directly from either independent claim 23 or 31, respectively, and thus include all the recitations of their corresponding independent claim. Thus, dependent claims 24-28, 30, 32 and 34 are patentable for at least the same reasons given above for independent claims 23 and 31.

Thus, for all the reasons stated above, the rejections of claims 23-29 and 30-34 are overcome.

Newly Added Claims

Applicant has added new claims 35-45 to more particularly define aspects of the present application. The new claims include no new matter and are fully supported by the specification and the drawings of the present application.

Accordingly, it is believed that the new claims are in condition for allowance.

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CONCLUSION

In view of the amendments and the remarks submitted above, it is respectfully submitted that the present claims are in condition for immediate allowance. It is therefore respectfully requested that a Notice of Allowance be issued. The Examiner is encouraged to contact Applicant's undersigned attorney to resolve any remaining issues in order to expedite examination of the present invention.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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